

### **REMARKS**

Applicant respectfully traverses the Examiner's rejections of claims 1-2 under 35 U.S.C. §103(a) over Hezel (EP 1 129 828), Larsson (USP 4,904,148), or Okamoto (JP 10-225881) in view of Akeel (USP 5,293,107) because, as will be explained in detail below, no *prima facie* case of obviousness has been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. MPEP § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." MPEP § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. MPEP § 2143.01(III) (emphasis in original). "All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art. " MPEP § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." MPEP § 2141(III).

Independent claim 1, as amended, calls for a combination including, for example, "a first joint arm having two motors for driving the first and second rotating shafts and a second joint arm with no motor, the first arm having a longer length than the second arm." As described in the specification of the present application at page 8, lines 4-10, the advantage of such an arrangement is that the total length of the robot is reduced.

As admitted by the Examiner, none of Hezel, Larsson, and Okamoto teaches or suggests the motor actuators being alternately arranged. See Office Action, page 4. The Examiner has further asserted that Akeel teaches positioning arms with a pair of motors and arms with no motor in an alternate manner. *Id.* As noted by the Examiner, Akeel teaches that a pair of motors (134, 136) positioned in a first arm part (148), no motors being positioned in an adjacent arm part (150), and a pair of motors (138, 140) being positioned in a third arm part (152). *Id.* Contrary to claim 1, Akeel, discloses in Figure 8, that two motors (134, 136) are positioned in a shorter joint arm (148) and a longer joint arm (150) has no motor. Akeel fails to recognize, disclose or suggest the advantageous arrangement recited in the present claim. None of the prior art references, and no combination thereof, teaches or suggests "a first joint arm having two motors for driving the first and second rotating shafts and a second joint arm with no motor, the first joint arm having a longer length than the second joint arm" as required in

amended claim 1. For these reasons, the Examiner has not established a *prima facie* case of obviousness with respect to amended claim 1. Claim 1 is therefore allowable over Hezel, Larsson, or Okamoto in view of Akeel. Claim 2 is dependent upon claim 1, and thus, also is allowable for at least the same reasons as stated above with respect to claim 1.


In view of the foregoing remarks, Applicant respectfully requests reconsideration of the application and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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